

REMARKS

Favorable reconsideration and allowance of the present patent application are respectfully requested in view of the following remarks. Claims 7-12 remain pending, of which claims 7 and 10 are independent.

§ 112, 1ST PARAGRAPH REJECTION

Claims 7 and 10 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the Applicant had possession of the claimed invention at the time the application was filed. More specifically, the Examiner asserts that the recitation "without checking for duplicate file names in the second loadable and removable recording medium" was not described in the specification. *See May 18, 2004 Office Action, pages 2-3, item 3.* Applicant respectfully disagrees.

In the specification, the following is described with respect to an embodiment of the present invention. Figures 4 and 5 are flow charts for describing the procedure of processing image file in the image file apparatus. As described, image

files that have been recorded on the first memory card 21 are read out (Step 34). Next, the processing for changing the file name is executed (Step 35). Figure 6 is a flow chart illustrating the procedure of processing of changing the file names. As disclosed, the final file number end of the image files that have been stored on the large-capacity floppy disk is read out (Step 51 of Figure 6). Then the numeral obtained in step 51 is incremented and becomes part of the new file name as shown in step 52. In other words, the large-capacity floppy disk is checked merely to retrieve largest number. There is **no** comparison made to determine if one file name is identical to another file name whatsoever. In other words, the feature of "without checking for duplicate file names in the second loadable and removable recording medium" is clearly disclosed in the specification. Therefore, contrary to the Examiner's assertion, Applicant did possess the claimed invention.

Applicant respectfully requests that Section 112, first paragraph rejection of claim 7 and 10 be withdrawn.

§ 103 REJECTION - FUKADA

Claims 7-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fukada et al. (EP 0 838 767 A2, hereinafter "Fukada"). Applicant respectfully traverses this rejection.

For a Section 103 rejection to be proper, a *prima facie* case of obviousness must be established. See *M.P.E.P.* 2142. One requirement to establish a *prima facie* case of obviousness is that the prior art reference must teach or suggest all claim limitations. See *M.P.E.P.* 2142; *M.P.E.P.* 706.02(j). Thus, if the cited reference fails to teach or suggest one or more claimed elements, then the rejection must fail.

In this instance, independent claim 7 recites, in part, "an image-file recording controller for changing a file name of the image file that has been read out of the first loadable and removable recording medium to the incremented file-number generated by said incrementing device and recording the read image file on the second loadable and removable recording medium without checking for duplicate file names in the second loadable and removable recording medium." Independent claim 10 recites a similar feature.

In the invention as claimed, it is not necessary to check for duplicate file names in the second loadable and recording medium. As noted above, the incrementing device that increments the last file number read out by the file-number read out device. As a result, the new file name is prevented from being a duplicate of other file names. Thus, the changing of the file name of the image file from the first device can be performed "without checking for duplicate file names in the second loadable and removable recording medium."

In the reply filed on March 17, 2004 (entered as a result of filing a request for continued examination on April 16, 2004) Applicant demonstrated that Fukada cannot be relied upon to teach or suggest at least this feature. Applicant maintains all traversal arguments made.

In response, the Examiner asserts that Figure 2 shows "the process of checking for duplication could be bypassed if there is no need to check for two files having a same file name." *Emphasis added; see May 18, 2004 Office Action, page 6, lines 7-9.* Applicant respectfully disagrees.

As shown in Figure 2 of Fukada, an image file is read from a memory card, and a temporary file name is determined from the

properties of the image file. See *Fukada*, column 6, lines 16-20. Referring back to Figure 2, once the temporary file name is determined, it is **always** checked to determine if the file names overlap. See also *Fukada*, column 6, lines 46-50. Indeed, when Figure 2 of *Fukada* is examined in detail, it is noted that the step of determining whether or not the file names overlap is **always** entered. Only the step of changing the identifying number can be bypassed if there is no overlap in the first place. Clearly, contrary to the Examiner's assertion, the process of checking for duplication to check for two files having a same file name is **never** bypassed as shown in Figure 2 of *Fukada*.

Clearly, because a check for duplication file names **must always** be made, *Fukada* is in complete contrast to the invention as claimed in the present application. Therefore, independent claims 7 and 10 are distinguishable over *Fukada*.

Claims 8, 9, 11 and 12 depend directly or indirectly from independent claims 7 and 10. Therefore, these dependent claims are distinguishable over *Fukada* for at least the reasons stated with respect to independent claims 7 and 10 as well as on their own merits.

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Applicant respectfully requests that the rejection of claims 7-12 based on Fukada be withdrawn.

CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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